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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,806	03/30/2004	William S. Kerker	9974-077	6026
757	7590	08/24/2005	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			MAI, THIEN T	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/812,806

**Applicant(s)**

KERKER ET AL.

**Examiner**

Thien T. Mai

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ✓ 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. Claim 19 recites the limitation "the invoice number" in relation with claim 13. There is insufficient antecedent basis for this limitation in the claim.

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim(s) 1-3, 5-6, 7-9, 11-19, 22-30, 33-36, 38-43, and 45 is/are rejected under 35 U.S.C. 102(b) as being anticipated by Williams (20020032612).

Regarding claim 1-3, 6, and 8, Williams discloses a system for return merchandise comprising:

- A merchant computer in network with a customer computer (Fig. 2)
- A first control logic for receiving merchandise identifier implicitly associated with the product description (Fig. 23a) and the quantity of merchandise being returned (Fig. 24)
- A second control logic for determining eligibility for return (Fig. 15)
- A third control logic for creating merchandise return form (Fig. 15, 24)
- A fourth logic for transmitting return form to the customer computer (Fig. 24)
- A fifth logic for receiving the edited return form (Fig. 26)
- A sixth logic for receiving an invoice identifier such as tracking number associating with the return transaction (Specification par. 0148. Fig. 71a, 43)

Regarding claim 5 and 9, Williams discloses the sixth logic comprises customer being prompted to enter a reason from a list (Fig. 24) to be sent to the merchant (Fig. 48).

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Regarding claim 7, Williams discloses the merchandise return being analyzed by SKU numbers (Fig. 61) inherently implies receiving them from customers.

Regarding claim 11, Williams discloses the fourth logic include displaying a quantity, merchandise identifier, description, a reason for return and an invoice identifier (Fig. 48)

Regarding claim 12, Williams discloses a label for printing and sent to the merchant (Fig. 27a)

Regarding claims 13-14, 17-18, and 22, see discussion regarding above claims.

Regarding claim 15, Williams discloses an inbound manager screen containing information regarding certain product(s) being returned including a quantity field (Fig. 58, Specification par. 0497), which inherently implies there must be a way for the customer to enter quantity of products being returned.

Regarding claim 16, Williams discloses a merchandise SKU being provided by customer through the selection of a particular product being returned.

Regarding claim 17-19, 22, and 23, see discussion regarding claims above.

Regarding claim 24, Williams discloses the means for creating an unwanted merchandise return form is residing in the memory of an Internet server (Figs. 12-17) operated by a merchant or a common provider for the merchants (see Abstract).

Regarding claims 25-30, 33-36, 38-43, and 45, see discussion regarding above claims.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim(s) 10, 20, 31, and 43 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (20020032612) in view of Junger (20040172260).

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Regarding claim 10, 20, 31, and 43, Williams discloses all limitations set forth in this claim as discussed above except for the second logic having verification of merchandise being previously returned. Junger discloses the identifier is also checked for duplicates (Specification par. 0090). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to implement the method of Junger with the motivation to avoid hassles by displaying the merchandise identifier on the invoice and to avoid and spot possible problems or abuse of merchandise return policy.

5. Claim(s) 4, 21, 32, 37, and 44 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams (20020032612) in view of Walters (20050114221).

Regarding claim 4, 21, 32, 37, and 44, Williams discloses all limitations set forth in these claims as discussed above except for a seventh logic for transmitting the invoice having merchandise identifier to the customer computer for display. Walters discloses an invoice showing a return order number, quantity, merchant name and address, and SKU number and Return Authorization number (Fig. 4F). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to be encouraged for utilizing Walters' teaching with the motivation for providing a detailed invoice serving as a proof to the customer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien T. Mai whose telephone number is 571-272-8283. The examiner can normally be reached on Monday through Friday, 8:00 - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thien T Mai  
Examiner  
Art Unit 2876

TM



**THIEN M. LE**  
**PRIMARY EXAMINER**